

**REMARKS**

1. **Status of the Claims**

Claims 1-18 are pending in this Application. None of the claims have been canceled. By this Response, Applicant amended claims 1 and 10. Applicant respectfully submits no new matter was added and that the amendments are fully supported by the application as originally filed. Accordingly, Claims 1-18 are at issue.

Initially, in the Office Action, the assumption is made that emulsifiers and stabilizers are one in the same, and thus the elimination of emulsifiers conflicts with the presence of stabilizers. Applicant respectfully submits that emulsifiers and stabilizers are different ingredients, having different functions in the formulation of dairy products. For example, emulsifiers make it possible to uniformly disperse tiny particles of globules of one liquid into another. Stabilizers, on the other hand, aid in maintaining smooth texture and uniform color and flavor. See attached from Darigold webpage. On the web page, guar gum and carrageenan are listed under the “Stabilizer” section, not under the “Emulsifier” section. Therefore, these ingredients are clearly known stabilizers, supporting Applicant’s assertion that stabilizers and emulsifiers should be considered separate ingredients when evaluating Applicant’s invention in view of the cited references.

In view of this evidence, Applicant respectfully submits that one skilled in the art, and in particular in the dairy product industry, would clearly not equate emulsifiers with stabilizers. Therefore, Applicant respectfully requests withdrawal of the rejection of claims 1-18 under 35 U.S.C. 112, first paragraph, and the rejection of claims 10-18 under 35 U.S.C. 112, second paragraph, in view of the fact that emulsifiers and stabilizers are two separate ingredients. Applicant respectfully submits that the specification supports the absence of an emulsifier in the products, as there is clearly no disclosure reciting the use of an emulsifier in the specification or in the examples of the present application.

2. Rejection of Claims under 35 U.S.C. 102

Claims 1-9 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,197,362 to Hussein. In order for a reference to act as a §102 bar to patentability, the reference must teach each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983). Without the required teaching of “each and every element” as set forth in the claims, it is improper to maintain such rejections under §102(b). Hussein does not teach each and every element of the claimed invention, and thus fails as an anticipatory reference.

The present invention is directed to a dairy-based pourable dessert topping without an emulsifier. Applicant’s dairy-based formulation does not require the presence of an emulsifier to create the desired taste, viscosity and soaking rate for use in the creation of a tres leches cake. Milk proteins are known to have natural emulsification properties, and because Applicant’s formulation is dairy based, it is not necessary to add a separate emulsifier to the formulation. Applicant further submits that an emulsifier and a stabilizer are two different ingredients, and that emulsifiers and stabilizer perform different functions in the composition.

On the other hand, Hussein discloses a pourable dessert liquid product. Hussein specifically lists separately an emulsifier **and** a stabilizer as ingredients in his formulation – “[t]he amount of emulsifier should be about 0.1 weight % to about 2.0 weight of the product . . .” (Col. 2, lines 24-26). Hussein then goes on to list examples of emulsifiers useful in his invention, for example, polysorbate 60 and 80, sodium stearyl lactylate, calcium stearyl lactylate, monoglyceride, diglyceride, and hexaglycol distearate (Col. 2, lines 26-31). Hussein does not teach or suggest that the emulsifier can be left out of his formulation, nor does he teach or suggest that stabilizers and emulsifiers are one in the same. Notably, all of Hussein’s examples include an emulsifier. Hussein specifically lists stabilizers and emulsifiers separately, further supporting the fact that stabilizers and emulsifiers are two different and required ingredients in Hussein’s formulation. If stabilizers and emulsifiers were one in the same ingredient with the

Page 6

same properties as asserted in the Office Action, then Applicant submits both ingredients would not be mentioned separately and one of them would not be necessary. Applicant does not agree that stabilizers and emulsifiers perform the same functions, and thus Applicant's formulation, which clearly lacks an emulsifier is not the same as the Hussein formulation. There is no teaching in Hussein that the emulsifier can be eliminated or substituted with something else, and therefore Hussein teaches away from the present invention. Applicant's formulation is different from Hussein's formulation.

Therefore, Applicant respectfully submits that because Hussein does not teach each and every element of the present invention, Applicant's invention is not anticipated by Hussein. Claims 2-9 depend from claim 1 and necessarily include all of its limitations. The dependent claims further include elements not found in the Hussein formulation, and therefore, these claims are likewise patentable over Hussein.

3. Rejection of Claims under 35 U.S.C. 103(a)

Claims 10-18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hussein in view of an article in Dairy Foods, titled "New Heights in Emulsifier Technology – Elimination of Polysorbate 80 from Dairy Food Formulations." Applicant respectfully submits that combination of the cited references is improper, but even if proper, Applicant's invention is patentable over the combination of references.

Initially, combination of the references is improper as there is no motivation in the references to combine them. *See In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995). There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination of references feasible. That knowledge cannot come from the Applicants' invention itself. *See In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79 (Fed Cir. 1988)); *In re Geiger*, 815 F.2d 686, 687 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147 (Fed. Cir. 1985). "The mere fact that

the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gormyan*, 933 F.2d 900, 902 (Fed. Cir. 1984)). Certainly, this rational is applicable in the present case.

Hussein was discussed above. The Dairy Foods article, which is a press article, not a scientific article, is directed to replacing emulsifiers, such as polysorbate 80, with a stabilizer/emulsifier blend. The article does not disclose elimination of the emulsifier all together, but rather teaches elimination of a type of emulsifier and replacement with an emulsifier/stabilizer blend of “mono- and diglycerides, locust bean gum, cellulose gum, guar gum and carrageenan.” (§ 6 of article). Hussein describes a pourable dessert liquid product, which specifically includes stabilizers **and** emulsifiers in the formulation. The Dairy Foods article discusses the replacement of a known emulsifier, polysorbate 80 with stabilizer/emulsifier blends. Therefore, both Hussein and the Dairy Foods article contain an emulsifier, and neither teaches elimination of the emulsifier.

However, the formulation of the present invention does not contain an emulsifier. It does not follow to combine the Dairy Foods article with the Hussein formulation to arrive at Applicant’s invention, and one skilled in the art would not combine these references to arrive at Applicant’s invention. Further, both references appear to teach away from the formulation of the present invention because they both contain an emulsifier, while the present invention does not.

Even if the combination was proper, Applicant’s invention is patentable over the combination. The present invention is directed to pourable dairy-based dessert product that does not contain an emulsifier. The formulation of Hussein clearly contains both a stabilizer and an emulsifier, without exception. The Dairy Foods article discusses replacement of a known emulsifier with stabilizer/emulsifier blend, still including, not deleting, the emulsifier. There is no teaching in Hussein that the formulation can be made without an emulsifier. Clearly, neither reference, alone or in combination, teach Applicant’s invention because neither reference teaches

**Atty Docket No. 77196-0025**  
U.S. Application No. 10/754,242

Page 8

the absence of an emulsifier. Therefore, Applicant submits claims 10-18 are patentable over these references.

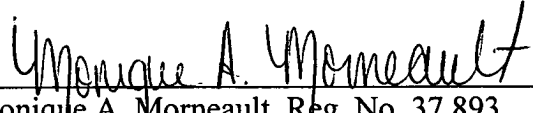
**CONCLUSION**

In light of the foregoing reasons, Applicant respectfully requests reconsideration and allowance of claims 1-18. The Commissioner is authorized to charge any additional fees or credit any overpayments associated with this Amendment to Deposit Account 13-0206.

Respectfully submitted,

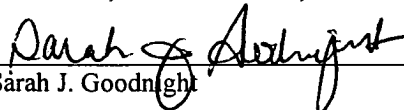
Date: December 26, 2007

By:

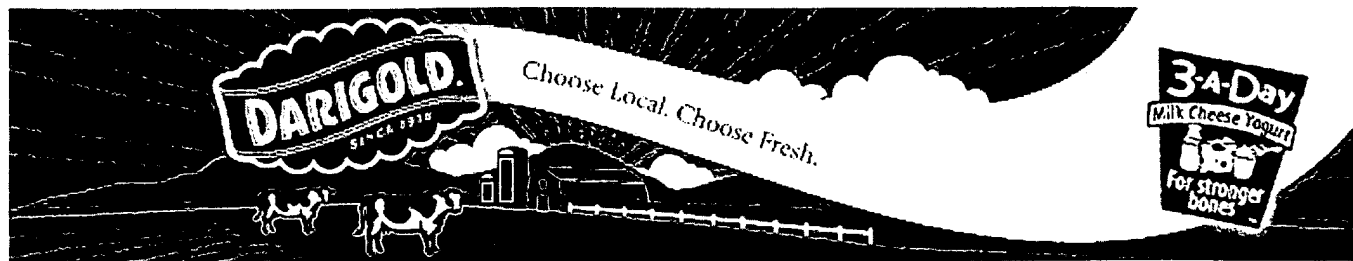
  
Monique A. Morneault, Reg. No. 37,893  
Customer No. 1923  
McDERMOTT WILL & EMERY LLP  
227 West Monroe Street  
Chicago, Illinois 60606-5096  
(312) 372-2000

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP RCE, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on December 26, 2007.

  
Sarah J. Goodnight

CHI99 49213681.077196.0025



## Q & A

# Questions & Answers

Interested in learning more  
about  
Darigold products?

Select a topic for important  
information.

[Aerosol Cream](#)

[Butter](#)

[Ensuring Fresh Dairy Products](#)

[Fat Free Half & Half](#)

[Ingredients In Dairy Products](#)

[Nutrient Content Claims](#)

[rbST Free Fiber 1% Lowfat Yogurt](#)

[rbST Free Milk](#)

[Substitutions](#)

[Ultra-Pasteurization](#)

[Value Added Milk](#)

[Whipping Fresh Cream](#)

[Yogurt and Cottage Cheese Use Lactose for Fuel](#)

## INGREDIENTS IN DAIRY PRODUCTS

Following is a list of stabilizers, emulsifiers, etc.

Emulsifiers make it possible to uniformly disperse tiny particles of globules of one liquid into another.

Stabilizers/Thickeners aid in maintaining smooth texture and uniform color and flavor in some foods.

Nutrient Supplements mainly vitamins and minerals, are added to improve the nutritive value of foods.

Colorings are used to enhance the appearance of foods.

Artificial Sweeteners are used in place of sugar for sweetening.

### **I. Emulsifiers**

Sodium & Potassium Phosphates

- $\text{NaPO}_3$ , water-binding agent
- $\text{KPO}_3$ , water binding agent

Polysorbate 80 – An emulsifier from natural vegetable fats and oils. Used in ice creams and frozen desserts for overrun and dryness.

Frequently used with mono-diglycerides.

Mon-and Diglycerides – Emulsifiers from natural vegetable fats and oils. For controlling the fat and moisture balance in mix. Prevents shrinkage.

### **II. Stabilizers**

Calcium Sulfate – Pure anhydrous calcium crystals derived from gypsum. Used in soft serve ice cream to produce dryness and stiffness.

Tragacanth – A gum produced from the astragalus bush. It swells in water to give a highly viscous paste. It is used in sauces, fruit fillings and citrus beverages.

Carob Bean Gum – Polysaccharide\*, extracted from the bean of the carob tree.

Modified Starch – Natural starch generally used for thickening of the fruit in the ice cream. Corn or tapioca base.

Guar Gum – Vegetable gum of the guar plant. For controlling free moisture in the ice cream mix. Gives smooth texture to frozen product.

Carrageenan – Derived from seaweed for control of free moisture in ice cream mix.

Propylene Glycol Alginate – Derived from seaweed for control of free moisture. Improves texture and body of frozen product.

Locust Bean Gum – Derived from the seed of the locust or carob plant. Gives smooth texture to frozen product.

Xanthan Gum – Produced by the fermentation of glucose by specific bacteria.